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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/893,805 | 06/28/2001 | Brian M. Grunkemeyer | MS174304.1 | 7100 |

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| EXAMINER |
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LEE, ANDREW CHUNG CHEUNG

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| ART UNIT | PAPER NUMBER |
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2616

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/16/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/893,805

Applicant(s)

GRUNKEMEYER ET AL.

Examiner

Andrew C. Lee

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7-14, 16, 18 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-14, 16, 18 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1, 7 – 14, 16, 18, 24 – 30 are pending.
2. Claims 2 – 6, 17, 19 – 23 canceled.

Claim Objections

3. Claims 1, 10, 11, 16, 27, 30 objected to because of the following informalities:

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The language “operable to”, “operably”, and “adapted to” does not have any weight, and hence the claimed subject matter follows those terms is optional to be considered or be evaluated.

- Regarding claim 1, the terms “operable to” in line 3, “operably” in line 4 is suggested to be modified.
- Regarding claim 10, the term “operable to” in line 2 is suggested to be modified.
- Regarding claim 11, the term “operable to” in line 2 is suggested to be modified.
- Regarding claim 16, the term “adapted to” in lines 14, 16, 18, 19, 20, 22, 23, and “operable to” in lines 24, 26 is suggested to be modified.
- Regarding claim 27, the term “operable to” in line 2 is suggested to be modified.
- Regarding claim 30, the term “adapted to” in line 1, and “operable to” in lines 3, 5, 7, 9 is suggested to be modified.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "a synchronous method call" in line 6, "an asynchronous method call" in line 7, "the asynchronous result object" in lines 11-12, "the address of an asynchronous callback routine" in line 14, "the begin asynchronous operation" in line 21. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the end asynchronous operation" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "synchronous method call code" in line 3, "the one or more constituent parts" in line 5, "the begin asynchronous operation" in lines 9 – 10. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "code for a synchronous method call" in line 1, "code for an asynchronous method call" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2616

Claim 24 recites the limitation "the begin asynchronous operation method" in line 8, "the address of an asynchronous callback routine" in line 11, "the asynchronous call state object" in lines 11 – 12, "the begin asynchronous operation" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "synchronous method call code" in line 3, "asynchronous method calling" in lines 16, 18, "the begin asynchronous operation method" in line 19, "the asynchronous result object" in lines 19 – 20, "the address of an asynchronous callback routine" in line 22, "the asynchronous call state object" in line 23, "the end asynchronous operation method" in line 24, "the asynchronous call result object" in line 27, "the begin asynchronous operation" in line 28. There is insufficient antecedent basis for this limitation in the claim.

Claim 27 recites the limitation "synchronous method call code" in line 4, "asynchronous method calling" in lines 14, 16, "the begin asynchronous operation method" in line 17, "the asynchronous result object" in lines 17 – 18, "the address of an asynchronous callback routine" in line 21, "the asynchronous call state object" in line 21 – 22, "the end asynchronous operation method" in line 24, "the asynchronous call result object" in line 28, "the begin asynchronous operation" in line 29. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites the limitation "synchronous method call code" in line 3, "asynchronous call of the target method" in line 19. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 24, 27, 16, 18, 25, 26, 28, 29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Considering claim 24,

To determine whether the claimed subject matter complies with the is eligibility requirement of 35 USC 101, we ask

Does the claimed invention fall within an enumerated statutory category? The answer is "No".

As evidenced at page 34, lines 19 to 23 of the specification, in "communication media typically embodies computer readable instructions, data structures, program modules or other data in a modulated data signal such as a carrier wave or other transport mechanism and includes any information delivery media. The term "modulated data signal" means a signal that has one or more of its characteristics set or changed in such a manner as to encode information in the signal". Thus, claim 24 is nothing more than a signal, and a signal is non-statutory subject matter. It is also well established that a software application, i.e. computer program, per se is not physical "thing". The computer program is neither computer

components nor statutory processes. Such claimed computer program does not define any structural and functional interrelationship between the computer program and the rest of the computer, which permits the computer program's functionality to be realized.

In addition, as set forth in the Interim Guidelines page 52, for a computer program to be statutory it must be embedded in a computer readable medium, and since claim 24 does not comply with the requirements of the Interim Guideline, it is non-statutory.

Thus, for the above reasons, claims 24, 27 are non-statutory.

As to claims 18, 25 – 26, 28, these claims are written in a form of "method". However, as evidenced in claim 18, claims 18, 25 – 26, 28, are claiming software in the form of method. Note that claims 18, 25 – 26, 28 mirrors claims 24, 27 in all respects except for the preamble and in light of the specification it is nothing more than the instructions of the application.

When claim 18 falls within one of the statutory categories, we continue to ask the following question.

Does the claimed invention cover a judicial exception? The answer is "Yes", i.e. abstract idea — computer program.

Once the claim covers a judicial exception, we need to determine whether there is a practical application recited in the claim. The final result achieved by claim 1 is to provide creating an asynchronous call state object to store state information associated with the asynchronous method call. It is clear that 1) there is no physical transformation recited in the claim, and 2) no useful and tangible result recited in the claim. Thus, claims 18, 25 – 26, 28

are also nonstatutory since the patent protection sought by the claimed invention is for the computer program in the abstract.

Claims 16 and 29 are also rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Although the preamble of claims 16 and 29 claim as system, claims 16 and 29 are rejected as being non-statutory, i.e. merely claiming program in the main context. Figs 5 – 11 describe claim subject matter and page 34 in the specification clearly stated these are computer programs with computer instructions and carrier wave and signal, and without practical application found in the claims, claims are nothing more than a computer program.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Lee whose telephone number is (571) 272-3131. The examiner can normally be reached on Monday through Friday from 8:30am - 5:00pm.

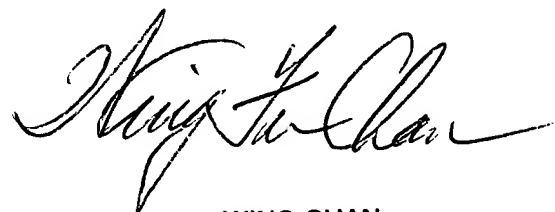
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on (571) 272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information

Art Unit: 2616

about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew C. Lee/ :: <3/20/2007>

A handwritten signature in black ink, appearing to read 'Wing Chan', with a stylized, flowing script.

**WING CHAN
SUPERVISORY PATENT EXAMINER**